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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/092,174	03/06/2002	Kevin Girard Conwell	13019	8623
7590 06/16/2004				
ORUM & ROTH SUITE 1616 53 W. JACKSON BLVD CHICAGO, IL 60604		EXAMINER NGUYEN, PHUNG		
		ART UNIT PAPER NUMBER		
		2632		
		DATE MAILED: 06/16/2004		

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/092,174

Applicant(s)

CONWELL ET AL.

Examiner

Phung T Nguyen

Art Unit

2632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-10 and 14-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-10 and 14-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 3, 4, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baldwin (U.S. Pat. 5,884,425) in view of Morgan (U.S. Pat. 5,560,657).

**Regarding claim 1:** Baldwin discloses an anti-tamper tag with theft protection comprising a tamper evident label material 45, with an adhesive 28 on a back side, and an RFID transponder 66 adhered to the adhesive (figure 5, col. 7, lines 6-16). Baldwin does not disclose the tamper evident label material is a vinyl with a tensile and tear resistance such that the tamper label material one of tears and breaks upon an attempted removal from a substrate. However, using a vinyl as the tamper evident label material is old and known in the art as taught by Morgan (col. 3, lines 44-57, and col. 5, lines 40-51). Therefore, it would have been obvious to the skill artisan to utilize the teaching of Morgan in the system of Baldwin because if the label material is made of vinyl, it would be easy to crack and break when removal from a substrate is attempted so that tampering is indicated.

**Regarding claim 3:** The combination does not disclose the tamper evident label material is 3M 7610 Scotch Destructible Vinyl as claimed. However, it would have been obvious to use 3M 7610 Scotch Destructible Vinyl as the tamper evident label material since they are commercially available in the market.

**Regarding claim 4:** Baldwin discloses a release liner 58 attached to the adhesive (figure 5, col. 7, lines 6-10).

**Regarding claim 14:** Baldwin discloses a release liner 58 attached to the adhesive (figure 5, col. 7, lines 6-10).

3. Claims 5, 6, 15, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baldwin in view of Morgan and further in view of Mandecki (U.S. Pat. 5,981,166).

**Regarding claim 5:** The combination does not disclose a hologram on the label material. However, Mandecki discloses a screening of soluble chemical compounds for their pharmacological properties utilizing transponders comprising the holographic encoding of an image of serial number (col. 4, lines 57-64). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teaching of Mandecki in the system of Baldwin and Morgan because they teach a system for security purpose which uses a transponder for transmission of data by reception of a predetermined signal. It is seen that using of holographic images would be an advantage for protecting articles from theft and for authenticating them.

**Regarding claim 6:** Mandecki discloses microprinting on the label material (col. 4, lines 55-57).

**Regarding claim 15:** Refer to claim 5 above.

**Regarding claim 16:** Refer to claim 6 above.

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4. Claims 7, 8, 17, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baldwin (U.S. Pat. 5,884,425) in view of Zarembo et al. (U.S. Pat. 5,477,219).

**Regarding claim 7:** Baldwin discloses a clear label material with a pigmented adhesive 28 on a back side, and an RF transponder 66 adhered to the adhesive (col. 7, lines 6-10). Baldwin does not disclose the separation of the tag from a substrate results in incomplete separation of the adhesive in the form of the silicone pattern and the pattern becomes visible as claimed. However, Zarembo et al. disclose a composite electronic article surveillance, identification, and security marker assembly and system comprising a layer of retroreflecting beads (silicone pattern) 14 as shown in figure 1, col. 3, lines 9-27. Therefore, it would have been obvious to the skilled artisan to employ the technique of Zarembo et al. in the system of Baldwin because they both teach a system which produces a tamper-indicating label when removal from a substrate is attempted. The teaching of Zarembo et al. would increase the flexibility of Baldwin's system by using a silicone pattern for identifying articles in order to prevent them from unauthorized removal.

**Regarding claim 8:** The combination does not disclose the tamper evident label material is one of 3M 7866, 3M 7389 and 3M 7385 as claimed. However, it would have been obvious to use one of 3M 7866, 3M 7389 and 3M 7385 as the tamper evident label material since they are commercially available in the market.

**Regarding claim 17:** Baldwin discloses a release liner 58 attached to the adhesive (figure 5, col. 7, lines 6-10).

**Regarding claim 18:** Refer to claim 17 above.

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5. Claims 9, 10, 19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baldwin in view of Zarembo et al. and further in view of Mandecki (U.S. Pat. 5,981,166).

**Regarding claim 9:** The combination does not disclose a hologram on the label material. However, Mandecki discloses a screening of soluble chemical compounds for their pharmacological properties utilizing transponders comprising the holographic encoding of an image of serial number (col. 4, lines 57-64). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teaching of Mandecki in the system of Baldwin and Zarembo et al. because they teach a system for security purpose which uses a transponder for transmission of data by reception of a predetermined signal. It is seen that using of holographic images would be an advantage for protecting articles from theft and for authenticating them.

**Regarding claim 10:** Mandecki discloses microprinting on the label material (col. 4, lines 55-57).

**Regarding claim 19:** Refer to claim 9 above.

**Regarding claim 20:** Refer to claim 10 above.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Barcikowski [U.S. Pat. 5,900,307] discloses self-laminating system for forming luggage tags.

b. Thomas [U.S. Pat. 6,419,391] discloses reclosable bags having a tamper evident stepped member.

c. Betterley [U.S. Pat. 4,300,297] discloses ticket.

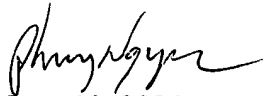
d. Zahner [U.S. Pat. 5,018,286] discloses tamper resistant ski ticket.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phung T Nguyen whose telephone number is 703-308-6252. The examiner can normally be reached on 8:00am-5:30pm Mon thru. Friday, with alternate Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel J. Wu can be reached on 703-308-6730. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-308-9051 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

Examiner: Phung Nguyen



Date: June 10, 2004